



#7  
PATENT  
741124-77

IN THE UNITED STATES PATENT AND TRADEMARK

In re Patent Application of )

Dieter BUSCH et al. )

Group Art Unit: 2859

Application No.: 09/924,870 )

Examiner: Y. Guadalupe

Filed: August 9, 2001 )

For: PROCESS AND DEVICE FOR )  
DETERMINING THE ALIGNMENT )  
OF A BODY WITH REGARD TO A )  
REFERENCE DIRECTION )

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TECHNOLOGY CENTER 2806

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*April Campbell*  
April Campbell

PETITION, UNDER 37 C.F.R. 1.181, REQUESTING  
WITHDRAWAL OF THE FINALITY OF THE OFFICE  
ACTION OF AUGUST 8, 2003

MAIL STOP PETITION  
Commissioner for Patents  
P.O. Box 1450  
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OFFICE OF PETITIONS

Dear Sir:

The Petitioners request the Commissioner invoke supervisory authority to instruct Examiner Guadalupe to withdraw the finality of the Office Action of August 8, 2003.

The relevant facts concerning this request are as follows:

1. The instant application was filed on August 9, 2001.

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2. On October 9, 2002, Examiner Guadalupe telephoned the undersigned to set forth a requirement for restriction between Group I, process claims 1-8, and Group II, device claims 9-16, and further to request an election of a Group by telephone. Group I, claims 1-8, was elected.

3. On October 31, 2002, the Examiner issued an Office Action, repeating the requirement for restriction between Groups I and II, as well as the election of the Group I (claims 1-8). The Office Action also rejected claims 1-8, under § 102(b) or § 103(a), over the teachings of Murray, Jr. ('005) alone or in combination with the teachings of Woyton ('335). In setting forth the requirement for restriction, the Examiner gave as a reason for distinctness between the inventions of Groups I and II that the Group I method can be practiced "by another materially different apparatus or by hand such as one process that does not require the use of an evaluation means."

4. An Amendment was filed in response to the first Office Action on April 30, 2003, in which the Applicants amended the elected claims 1-8 to include the following features:

1. (Currently Amended) Process for determining the alignment of a body mounted to rotate around a lengthwise axis of the body with respect to a reference direction and including a position measurement probe, comprising the steps of which is calibrated to the reference direction and attached calibrating the position measurement probe relative to the reference direction using a coordinate system that is external to the mounted body to be aligned and fixed relative to the location of said body, attaching the measurement probe on the end face of the body or at a longitudinal axis of the body on a surface essentially parallel to the end face of the body, comprising performing position measurements in at least three measurement positions, each of which differs from the others one another by an angle of rotation of the body around the lengthwise axis of the body, with one position measurement at a time being taken, and computing using an evaluation means to compute the alignment of the body with respect to the reference direction from the measurement data gathered from the at least three measurement positions relative to said coordinate system. (Emphasis added)

while also amending the non-elected independent claims 9, 14, 15 and 16 in a similar fashion, for purposes of rejoinder under the guidelines of MPEP Chapter 821.04, to include the features "at a longitudinal axis of the body on" and "using a coordinate system that is external to the mounted body to be aligned and fixed relative to the location of said

body." The Applicants also traversed the reasons for restriction by stating that with the scope of the now amended claim 1 being inclusive of an "evaluation means" like non-elected claim 9, restriction between claims 1 and 9 no longer appropriate. With regard to the prior art rejections, the Applicants further asserted that neither the Murray or Woyton patents teach the (claim 1) calibration and alignment process which employs a coordinate system that is external to the mounted body being aligned.

5. A second final Office Action was issued by Examiner Guadalupe on August 8, 2003, in which the Examiner indicates rejoinder of the non-elected inventions, pursuant to 37 C.F.R. 1.142, and includes new grounds of rejection for claims 1-17, under § 102(e) or § 103(a), over the teachings of Busch et al ('378) alone or in combination with the teachings of Woyton ('335). It is also stated, that since the Applicants' amendments to the claims necessitated the new grounds of rejection, then it is proper, according to MPEP Chapter 706.07(a), to make the Office Action "Final."

6. On August 19, 2003, the Applicants' representatives contacted Examiner Guadalupe and acting Supervisory Patent Examiner Lefkowitz, to discuss the finality of the August 8<sup>th</sup> Office Action, since the rejoinder of non-elected claims 9-17 with the elected claims 1-8 and finality of the Office Action appears to be in contrast with the USPTO policy, set forth in MPEP Chapter 821.04, of encouraging amendments to the non-elected claims in order to maintain the same limitations as the elected claims which will enable rejoinder upon allowance of the elected claims. Further noted by the Applicants' representative was the fact that the Applicants have been precluded from freely amending the features of original non-elected claims 9-16, particularly the previously un-examined features of claims 15 and 16 which are drawn to a printing press and machine for producing thin sheets. Both Examiner Guadalupe and acting Supervisory Patent Examiner Lefkowitz stated that since the Applicants' amendments to the claims 1, 9, 14, 15 and 16 necessitated a further search the finality was entirely proper. Acting Supervisory Patent Examiner Lefkowitz further stated that presenting similar amendments to all the claims, both elected and non-elected, is no different

than submitting an entirely new set of claims with the newly added limitations and the original features of the non-elected claims, i.e., in either situation finality would be proper if a new search was necessitated.

### PETITIONER'S ARGUMENTS

Since Examiner Guadalupe's refusal, as well as acting SPE Lefkowitz' refusal, to withdraw the finality of the Office Action of August 8<sup>th</sup> must be considered a request for reconsideration of the finality of the August 8<sup>th</sup> Office Action, the instant petition, under 37 C.F.R. 1.181, is considered both timely and proper.

The Applicant asserts that the finality of the August 8, 2003 Office Action must be withdrawn for several reasons. Initially, the Applicants assert that if allowed to remain, the finality decision of the Examiner would effectively remove the USPTO efforts to reduce the backlog of applications by reducing the number of divisional applications as encouraged by the stated policy in MPEP Chapter 821.04. That policy permits rejoinder of product (device) and process claims if the non-elected claims, at the time of allowance of the elected claims, contain the same limitations as the elected claims. That is, the Examiner's and Art Unit's policy of making final any office action, if a further search is necessitated by the amendment, after rejoinder of the non-elected inventions effectively removes any incentive to the Applicants of complying with the policy permitted by MPEP 821.04 since the Applicants will be afforded no opportunity to freely amend (like in a new divisional application) the unique features of the originally presented, non-elected claims, such as the printing press and machine features of claims 15 and 16.

Additionally, the Applicants assert that the finality is improper since the original restriction was improper at least with regard to original claims 1-8 and claim 14. That is, original claims 1 and 8 set forth a process for aligning a body utilizing a position measurement probe attached to the end face of the body; while independent claim 14 sets forth a device for aligning a body comprising a position measurement probe and an attachment means for attaching the position measurement probe to an

end of the body. Since claim 14 (and claims 15-16) does not contain an "evaluation means" recited in independent claim 9, the Examiner's stated reason (see paragraph 3 above) for establishing distinctness of the elected claims 1-8 from claims 14-16 was not proper. Consequently, the restriction between claims 1-8 and claims 14-16 was not proper. As a result, the Examiner's instant prior art rejection of the (originally) presented features of claims 14-16, particularly the printing press and machine features of claims 15-16, which had not been previously rejected under any grounds of rejection was not necessitated by amendment, and, therefore, the finality of the August 8<sup>th</sup> Office Action is improper.

In addition to the above reasons for removing the finality of the August 8<sup>th</sup> Office Action, the Applicants also note that the Examiner's Office Action does not comply with the principal requirement for making an Office Action final on the second and subsequent action as set forth in MPEP Chapter 706.07 which states:

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.

A review of both the § 102(e) or § 103(a) rejections in the August 8<sup>th</sup> Office Action reveals that the Examiner never addresses the "Printing press..comprising" or "Machine for producing thin sheets...comprising" features of either claims 15 or 16. As a result, the Examiner's failure to treat each feature of the claimed invention deprives the Applicants of the benefit of the Examiner's understanding and interpretation of the Busch et al and Woyton reference in regard to those features, and further deprives the Applicants the opportunity to freely amend those features to attain allowable subject matter or better define the invention for purposes of appeal.. In light of the failure of the August 8<sup>th</sup> Office Action to address all the features of claims 15

and 16, no clear issue has been developed between the Examiner and the Applicants with regard to the claimed invention, and, consequently, the finality is improper and must be withdrawn.

### CONCLUSION

For all of the above mentioned reasons, the Applicants request that the finality of the August 8, 2003 Office Action be withdrawn. Additionally, since the shortened statutory period for response to the August 8, 2003 Office Action continues to run, prompt attention to this matter would be greatly appreciated.

This petition is submitted under 37 C.F.R. 1.181 (no fee). However, should it be determined that a fee is due in order to complete this filing, the Commissioner is hereby authorized to charge any required fee, or credit any overpayment, to Deposit Account No. 19-2380 (741124-77).

Respectfully submitted,

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By: 

David S. Safran

Registration No. 27,997

**NIXON PEABODY, LLP**

401 9<sup>th</sup> Street, NW, Suite 900

Washington, DC 20004-2128

(202) 585-8000 / 703-827-8094

(202) 585-8080 facsimile